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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,709	08/05/2003	Amy Mac Bunker	PC25236A	7386

28880 7590 06/28/2006
WARNER-LAMBERT COMPANY
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EXAMINER
BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/634,709	BUNKER ET AL.	
	Examiner	Art Unit	
	Venkataraman Balasubramanian	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,14 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 12,14 and 16-20 is/are allowed.
- 6) ☐ Claim(s) 21 is/are rejected.
- 7) ☐ Claim(s) 22-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response, which includes amendment of claim 17, filed on 4/7/2006, is made of record.

In view of applicants' response, the 112 second paragraph rejection and 102 rejection over Riordan et al., and Strobel as well as 103 rejection over Strobel have been obviated. However, the following apply.

Information Disclosure Statement

In view applicants assertion that an Office action of another examiner is a proper Information Disclosure Statement and that MPEP 609.04 permits such an entry, the office action presented in the Information Disclosure Statement is initialed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable Riordan et al., US 5,756,524 for reasons of record. To repeat:

Riordan et al. teaches several anilide derivatives as fungicides, which include compounds embraced in the instant claim. See formula I, column 1, and note the definition of various variable groups A, X, Y, Z and R¹. Note when A is a six-membered heteroaryl containing one nitrogen, the compounds taught by Riordan et al. include instant compounds. Especially see column 5-18 for examples of various pyridyl compounds made. Particularly see compound 37 and also see compounds 128, 148, 155.

Riordan et al. differs from the instant claims in exemplifying only few 5-membered heteroaryl substituted pyridyl compounds.

However, Riordan et al. teaches equivalency of those compounds taught in column 5-18 with those generically recited in column 1 for compound of formula I.

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Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Riordan et al and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action. Applicants' traversal is not persuasive.

First of all, contrary to applicants' urging, Riordan permits further substituent on A which includes as noted above several heterocyclic rings which may further be substituted. Hence, generically, Riordan et al., teaches instant compounds. Again as noted in the Table, there are several pyridyl compounds both 2-pyridyl and 3-pyridyl compounds. And there are examples of 3-pyridyl compounds further bearing a 5-membered-heteroaryl as required by the instant claim. See example 37, 128, 148, 155.

Secondly, claim 21 does not have the same proviso of claim 17.

Thirdly, Riordan et al., clearly teaches equivalency of 3-pyridyl compounds with 2-pyridyl compounds both in generic teaching and specific species teaching.

Fourthly, while said 3-pyridyl compound(s) doesn't anticipate the scope of instant claims, they are very closely related, being positional isomers of compounds i.e. 2-pyridyl of instant R₁ vs 3-pyridyl of the reference. However, positional isomers are not deemed patentably distinct absent evidence of superior or unexpected properties. See In re Crounse, 150 USPQ 554; In re Norris 84 USPQ 458; In re Finely 81 USPQ 383 and 387; Ex parte Engelhardt, 208 USPQ 343; Ex parte Henkel, 130 USPQ 474, regarding positional isomers.

Thus it would have been obvious to one skilled in the art at the time of the invention was made to expect instant compounds to possess the utility taught by the applied art in view of the close structural similarity outlined above.

Hence, this rejection is proper and is maintained.

Allowable Subject Matter

Claims 12, 14 and 16-20 are allowed. Claims 22-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571)

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272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is (571) 272-0661.

The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).


Venkataraman Balasubramanian

6/26/2006